

REMARKS

In a restriction requirement dated March 9, 2004, the Examiner required restriction under 35 U.S.C. § 121 between:

Group I, claims 8-10, 37, 38, and 40, characterized by the Examiner as drawn to a method for issuing a guarantee certificate; and

Group II, claims 15-17, 36, 39, 41, and 42, characterized by the Examiner as drawn to a method for issuing a guarantee certificate.

The Examiner specified that both Groups belong to the same class/subclass, namely, class 705, subclass 38.

The Applicants thank the Examiner for the telephone interview with the Applicants' representative on March 23, 2004. Applicants appreciate the Examiner's consideration, but were disappointed that the Examiner did not withdraw this restriction requirement. Applicants' regret that the Examiner's supervisor was not able to attend the Interview due to an emergency, but understand that the Examiner's supervisor discussed the restriction requirement with the Examiner. Applicants appreciate the Examiner's agreement to reconsider the restriction requirement again based on this Response.

In accordance with MPEP § 818.03(b), the Applicants provisionally elect, with traverse, to prosecute Group I, claims 8-10, 37, 38, and 40, characterized by the Examiner as drawn to a method for issuing a guarantee certificate.

Applicants traverse the restriction requirement. Applicants submit that it is not a serious burden to search and examine all the claims together. This is evidenced by previous office actions, in which the Examiner already searched and examined all the claims together.

Furthermore, the Examiner has not demonstrated a serious burden to search and examine all the claims together as required by the MPEP. (See MPEP § 803). Classification of the claim groups into different classes and subclasses is a prima facie demonstration of serious burden. Here, however, the Examiner has classified all the claim Groups in the same class and subclass, namely class 705, subclass 38. In the office action, the Examiner gives no explanation as to why it is a serious burden to search a single class and subclass for similar methods for issuing a guarantee certificate. Instead, the Examiner merely offers a conclusory statement that the inventions require separate searches.

In addition, the Examiner did not demonstrate that the two Groups were distinct inventions. In the restriction requirement, the Examiner asserted that Groups I and II are subcombinations usable together. To demonstrate distinctness of the subcombinations, the Examiner has the burden of providing an example of separate utility for each invention of each subgroup. (MPEP § 806.05(d); MPEP § 816). The restriction requirement is deficient because the Examiner has not provided such an example to meet his burden. Instead the Examiner merely states that “the utility of invention I is different from that of invention II.” This conclusory statement does not provide an example of separate utility for each group as required by MPEP § 806.05(d).

Moreover, examination of the claims and specification makes clear that the method of Group I has the same utility as the method of Group II, namely to issue a Guarantee Certificate.

In view of the foregoing remarks, Applicants respectfully request withdrawal of the restriction requirement, examination of this application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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